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10/698,506

10/31/2003

Vincent Vaccarelli

LEAP:129US

9595

7590

09/15/2004

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EXAMINER

NGUYEN, THONG Q

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/698,506 | <b>Applicant(s)</b><br>VACCARELLI, VINCENT |  |
|                              | <b>Examiner</b><br>Thong Q Nguyen    | <b>Art Unit</b><br>2872                    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/26/04</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The foreign reference DE 197 36 470 listed in the information disclosure statement filed on 2/26/2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Drawings***

2. The drawings contain four sheets of figures 1a-11 were received on 10/31/2003. These drawings are approved by the Examiner.

### ***Specification***

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

4. The disclosure is objected to because of the following informalities: a) Page 3, section [0009], the number "199 05b490" should be changed to ---199 05 490--; b) Page 7, section [0021], line 2 of the section, "slide2" should be changed to --slide 2--, and on line 4 of the section, "first" should be changed to --second-- (see line 1 of the section); c) Page 8, section [0023], the description thereof "The at least...any injuries" has at least one grammatical error; d) Page 8, section [0026], line 2 of the section, the reference

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"32" should be changed to --34-- (see line 1 of the section); e) Page 8, section [0027], line 2 of the section, the reference "32" should be changed to --36-- (see line 1 of the section); f) Page 8, section [0028], line 2 of the section, the reference "32" should be changed to --38-- (see line 1 of the section). There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to provide a proper antecedent basis for each of the mentioned features recited in present claims.

First, the specification fails to provide support for the feature thereof "thereby leaving...preparation" as recited in present claim 14, line 3;

Second, the specification fails to provide support for the feature thereof "the printed characters...in one color" as recited in present claim 16, line 2 and the feature that the color is black as recited in present claim 17, line 1;

Third, the specification fails to provide support for the feature thereof "the printed representation ... the sticker" as recited in present claim 20, lines 1-2; and

Fourth, the specification fails to provide support for the feature thereof "the sticker ... the microscope slide" as recited in present claim 21, lines 1-2.

*Applicant should note that the specification, section [0018], lines 9-10 of the section discloses that the non-transparent layer can be embodied as a color etching or a colored coating. The specification has not provided any*

*description/information that each of the printed characters and the printed representation of the preparation is printed in color as claimed in claims 16, 17, and 20.*

### **Claim Objections**

6. Claims 18 and 22 are objected to because of the following informalities.

Appropriate correction is required.

In each of claims 18 and 22, on line 2 of each claim: the phrase thereof "arranged the rectangular slide on opposite ends of the rectangular slide" should be changed to --arranged on opposite ends of the rectangular slide--.

### **Claim Rejections - 35 USC § 102**

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Weissman (U.S. Patent No. 5,561,556).

Weissman discloses a slide for supporting a specimen and a means carrying information of the slide and the specimen. In the embodiment as described in columns 5-6 and shown in fig. 2, the slide (1') is made by a transparent material (see column 4) comprises two areas in which one area is used to support a specimen (2') and the other area is used to support a read/writeable strip (6b) which carries information of patient identification and a label (4) which also

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carries information of the patient. The information carried by other area is able to read by a machine and/or by a human being. It is noted that the use of strip and label in the other area provides a gripping area for handling the slide and thereby leaving no fingerprints on the area supporting the specimen.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weissman in view of Speelman (U.S. Patent No. 3,672,745).

The slide as provided by Weissman provided in columns 5-6 and shown in figure 2 does not disclose that the slide has four round corners and a surrounding edge of a trapezoidal configuration as claimed in present claims 10 and 13, respectively. However, the use of a slide made by a transparent material and is used to support a specimen wherein the slide has four round corners and a surrounding edge of a trapezoidal configuration is known in the art as can be seen in the slide provided by Speelman. In particular, in columns 1-2 and figs. 1-2 Speelman discloses a slide (10) has four round corners (20) and a surrounding edge (18) so that a use can use the slide for the purpose of smearing a specimen and for reducing any danger of cutting the fingers of the user (see column 1). Thus, it would have been obvious to one skilled in the art at the time the

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invention was made to modify the slide provided by Weissman by making the corners of the slide as round corners and the edge as an edge having a trapezoidal configuration as suggested by Speelman for the purpose of smearing a specimen and for reducing any danger of cutting the fingers of the user.

Regarding to the feature related to the shape of the surrounding edge of the slide, i.e., a round configuration or a triangular configuration, as recited in present claims 11-12, such a recitation is merely that of a preferred embodiment and no criticality has been disclosed. The support for that conclusion is found in the present claim 13 in which applicant has claimed that the surrounding edge of the slide has a trapezoidal configuration. It is also noted that it would have been an obvious matter of design choice to one skilled in the art to utilize any suitable shape for the edge of the slide for the same purpose since it was decided in the Courts that a change in shape is generally recognized as being within the level of ordinary skill in the art. See *In re Dailey*, 149 USPQ 47 (CCPA 1976).

11. Claims 1-6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson, Jr. (U.S. Patent No. 5,111,344) in view of Domanik et al (U.S. Patent No. 5,963,368).

Robinson, Jr. discloses a glass microscope slide having an opaque marking surface formed thereon. The marking surface may be formed on either end of the slide. In other words, in the embodiment as described in columns 2-4 and shown in figs. 3-4, the slide (20) comprises two marking surfaces (24) formed on two opposite ends of the slide and an area defined between the two marking

surfaces, as understood, is used to support a specimen. The marking surface is made by colored material. However, Robinson, Jr. does not clearly disclose that printed information is provided on the marking surface as claimed.

The use of a slide having printed information which is printed directly on an area of a slide or printed in a label and then adhered the label onto an area of a slide wherein the printed information is the information related to the patient identification is known to one skilled in the art as can be seen in the slide provided by Domanik et al. In particular, in columns 3-4 and fig. 3, Domanik et al disclose a slide (12) having three areas (14, 16, 18) in which one area (18) is used to support printed information (22) contained both information in the form of a bar code (24) readable by a machine and information in the form of characters/numbers (26) readable by a human being, and another area (16) adjacent to the area (14) supported printed information for supporting a specimen. It is noted that the use of area supporting printed information provides a gripping area for handling the slide and thereby leaving no fingerprints on the area supporting the specimen.

Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the slide provided by Robinson, Jr. by utilizing printed information formed directly on the marking surface or printed information formed on a label which label is able to adhere to the marking surface as suggested by Domanik et al for the purpose of providing information of a patient



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having the specimen in the slide wherein the information is readable by either a human being or a machine.

12. Claims 7-9 and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson, Jr. in view of Domanik et al as applied to claim 1 and 5 above, and further in view of Olofson (U.S. Patent No. 5,598,295).

The combined product as provided by Robinson Jr. and Domanik et al does not clearly disclose that one of the marking surface is used for information readable by a machine or a human being and the other marking surface is used to support the information representing the specimen. However, the use of two marking surfaces wherein each marking surface is used to support different information in which one marking surface is used to support information of a specimen of a patient is known to one skilled in the art as can be seen in the slide provided by Olofson. In particular, in columns 2-3 and figs. 1-3, Olofson disclose the use of two marking surfaces wherein one surface is coated by coating (14) in which information (28) is provided and one surface area is used to support personal identification mark (32) such as the name of the user. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined product provided by Robinson Jr. and Domanik et al by using different marking areas for supporting different information as suggested by Olofson so that one marking area is used to support information related to a user having the specimen supported by the slide and the other marking surface/area for supporting other information.

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13. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson, Jr. in view of Domanik et al as applied to claim 1 above, and further in view of Speelman.

The combined product as provided by Robinson, Jr. and Domanik et al as described above does not disclose that the slide has four round corners and a surrounding edge of a trapezoidal configuration as claimed in present claims 10 and 13, respectively. However, the use of a slide made by a transparent material and is used to support a specimen wherein the slide has four round corners and a surrounding edge of a trapezoidal configuration is known in the art as can be seen in the slide provided by Speelman. In particular, in columns 1-2 and figs. 1-2, Speelman discloses a slide (10) has four round corners (20) and a surrounding edge (18) so that a use can use the slide for the purpose of smearing a specimen and for reducing any danger of cutting the fingers of the user (see column 1). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined product provided by Robinson Jr. and Domanik et al by making the corners of the slide as round corners and the edge as an edge having a trapezoidal configuration as suggested by Speelman for the purpose of smearing a specimen and for reducing any danger of cutting the fingers of the user.

Regarding to the feature related to the shape of the surrounding edge of the slide, i.e., a round configuration or a triangular configuration, as recited in present claims 11-12, such a recitation is merely that of a preferred embodiment and no

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criticality has been disclosed. The support for that conclusion is found in the present claim 13 in which applicant has claimed that the surrounding edge of the slide has a trapezoidal configuration. It is also noted that it would have been an obvious matter of design choice to one skilled in the art to utilize any suitable shape for the edge of the slide for the same purpose since it was decided in the Courts that a change in shape is generally recognized as being within the level of ordinary skill in the art. See *In re Dailey*, 149 USPQ 47 (CCPA 1976).

### ***Conclusion***

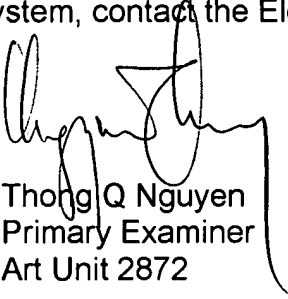
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen  
Primary Examiner  
Art Unit 2872

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